

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on July 11, 2008, the following reiterated grounds of rejection are set forth:

### ***Terminal Disclaimer***

The terminal disclaimer filed on July 11, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,566,720 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 8-25 and 35-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,567,880 to Goodman in view of U.S. Patent No. 6,221,007 to Green.

**In regards to claims 2-6, 9, 12-14, 17-21 and 36-46**, Goodman discloses an endoscope valve assembly comprising: a housing 58 comprising an opening; an inlet port 74/78 configured to be releasably connected to a source of irrigation fluid; an outlet port 76/80 configured to be releasably connected to an irrigation port of a medical endoscope; a valve carried by the housing and comprising a manually-controlled

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actuator movable between a first position, in which the valve blocks flow between the inlet port and the outlet port, and a second position, in which the valve allows flow between the inlet port and the outlet port; a latch operative to releasably hold the actuator in a selected position; and a mounting surface having a non-linear shape to allow the endoscope valve assembly to fit on medical endoscopes with different shapes, wherein the mounting surface comprises a surface of a mounting pad (see Figs. 1-5 and Col. 6, Lines 1-51). Goodman is silent with respect to a strap configured to secure to the housing through the opening and configured to releasably secure the endoscope valve assembly to the medical endoscope. Green an analogous endoscopic system comprising a strap 85 of adjustable length and an adjustment knob 90 with which the strap can be shortened until it firmly grips the endoscopic head (see Fig. 1 and Col. 7, Lines 24-41). Furthermore, Green teaches a wrist strap 1270 that is releasably secured to a surgeon's wrist during use through a fastener. Thereby the weight of the accessory is transferred to the surgeon's wrist and not to the endoscope or surgeons fingers (see Fig. 42 and Col. 20, Lines 23-35). Thus, Green teaches the desirability of attaching accessories to the external housing of an endoscope, or a surgeon's wrist, via a strap. It would have been obvious to one skilled in the art at the time the invention was made to secure the valve assembly of Goodman to the endoscope using a strap to provide increased efficacy in the adjustability of attaching the valve to a variety of endoscopes as taught by Green.

**In regards to claims 8, 10-11, 15-16, 22-25 and 35,** Goodman discloses an endoscope valve assembly comprising: a housing 58; an inlet port 74/78 configured to

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be releasably connected to a source of irrigation fluid; an outlet port 76/80 configured to be releasably connected to an irrigation port of a medical endoscope; a valve carried by the housing and comprising a manually-controlled actuator movable between a first position, in which the valve blocks flow between the inlet port and the outlet port, and a second position, in which the valve allows flow between the inlet port and the outlet port; and a mounting surface having a non-linear shape to allow the endoscope valve assembly to fit on medical endoscopes with different shapes; and a mechanical fastener configured to releasably secure the endoscope valve assembly to the medical endoscope (see Figs. 1-5, Col. 3, Lines 5-32 and Col. 6, Lines 1-51). Goodman is silent with respect to wherein the mounting surface comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing. Green teaches of an analogous endoscopic system wherein a video display 150 is releasably affixed to the cannula by mounting means comprising a support member 154, a Velcro strip 155, adhesively bonded to the support member and a corresponding fabric anchoring strip 160 adhesively bound to the cannula (see Fig. 5 and Col. 8, Lines 36-46). Thus, Green demonstrates that it is well known in the art to secure an apparatus to the body of an endoscope via a mounting pad comprising a resilient material and separately formed from the housing. It would have been obvious to one skilled in the art at the time the invention was made to secure the valve assembly of Goodman to the endoscope using a mounting pad to provide increased efficacy in the adjustability of attaching the valve to a variety of endoscopes as taught by Green.

Claims 8, 10-11, 15-16, 26-28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,201,908 to Jones in view of U.S. Patent No. 6,221,007 to Green.

**In regards to claims 8, 10-11, 15-16 and 35,** Jones discloses an endoscope valve assembly comprising: a housing 100; an inlet port 130 configured to be releasably connected to a source of irrigation fluid; an outlet port 138 configured to be releasably connected to an irrigation port of a medical endoscope; a valve carried by the housing and comprising a manually-controlled actuator movable between a first position, in which the valve blocks flow between the inlet port and the outlet port, and a second position, in which the valve allows flow between the inlet port and the outlet port; and a mounting surface having a non-linear shape to allow the endoscope valve assembly to fit on medical endoscopes with different shapes, and a mechanical fastener 104 configured to releasably secure the endoscope valve assembly to the medical endoscope (see Figs. 9-10 and Col. 6, Line 50 – Col. 7, Line 50). Jones is silent with respect to wherein the mounting surface comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing. Green teaches of an analogous endoscopic system wherein a video display 150 is releasably affixed to the cannula by mounting means comprising a support member 154, a Velcro strip 155, adhesively bonded to the support member and a corresponding fabric anchoring strip 160 adhesively bound to the cannula (see Fig. 5 and Col. 8, Lines 36-46). Thus, Green demonstrates that it is well known in the art to secure an apparatus to the body of an endoscope via a mounting pad comprising a resilient material and separately formed

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from the housing. It would have been obvious to one skilled in the art at the time the invention was made to secure the valve assembly of Jones to the endoscope using a Velcro mounting pad to more securely attach the valve to a variety of endoscopes as taught by Green.

**In regards to claims 26-28**, Jones discloses an endoscope valve assembly, further comprising a second inlet port operative to connect a suction source 132 and a second valve carried by the housing and coupled between the second inlet port and the outlet port, the second valve comprising a manually-controlled second actuator movable between a third position, in which the second valve blocks flow between the second inlet port and the outlet port, and a fourth position, in which the second valve allows flow between the second inlet port and the outlet port (see Figs. 9-10 and Col. 6, Line 50 – Col. 7, Line 50).

### ***Response to Arguments***

Applicant's arguments filed July 11, 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., designed to be an add-on component) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant states that Goodman fails to disclose a valve that fits on a medical endoscope and that the valve is part of the endoscope. Examiner

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disagrees. Goodman clearly discloses that the valve unit 46 which is mounted on the bridge element 42 (see Figs. 1-3 and Col. 5, Lines 34-56). Thus the valve assembly clearly has a mounting surface which is capable of being mounted on endoscopes of varying sizes. Furthermore, Goodman also teaches that a variety of different endoscopes (i.e. telescopes) may be passed through the valve assembly and sheath. The valve is also intended to be used on a variety of endoscope as Goodman discloses that the instant invention provides an effective endoscopic device which can be embodied in various forms for endoscopy of various parts of the human body, including the ureter, and it includes means for effectively controlling the irrigation and drainage of fluids in the area of the body being treated (see Col. 2, Lines 62-68). It is well known in the art that endoscopes for various parts of the body have varying lengths depending upon the desired depth of insertion needed within the body. Thus, an endoscope used for urological purposes would have a different length than an endoscope used for cardiac purposes. The insertion shaft 12 could theoretically be any desired length and thus the medical endoscope would have different shapes. As broadly as claimed, Goodman meets the limitations of the recited claims as the valve assembly can fit on endoscopes having different shapes (i.e. different lengths). The same reasoning is used to justify the rejection under Jones, which also meets the limitations as broadly as claimed.

Applicant states that Goodman fails to disclose a mounting pad comprising a resilient material. Examiner agrees and has rejected the claims under Goodman in view of Green as seen above and now reiterated:

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Goodman is silent with respect to wherein the mounting surface comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing. Green teaches of an analogous endoscopic system wherein a video display 150 is releasably affixed to the cannula by mounting means comprising a support member 154, a Velcro strip 155, adhesively bonded to the support member and a corresponding fabric anchoring strip 160 adhesively bound to the cannula (see Fig. 5 and Col. 8, Lines 36-46). Thus, Green demonstrates that it is well known in the art to secure an apparatus to the body of an endoscope via a mounting pad comprising a resilient material and separately formed from the housing. It would have been obvious to one skilled in the art at the time the invention was made to secure the valve assembly of Goodman to the endoscope using a mounting pad to provide increased efficacy in the adjustability of attaching the valve to a variety of endoscopes as taught by Green.

Applicant states that the endoscope of Jones does not have an irrigation port. Examiner disagrees. The access channel may channels 60 may be separate tubular channels extending axially between the main endoscope channel 37 and the wall of the sheath 30 as illustrated in FIG. 8. Alternately, flexible portion 16 and sheath 36 when viewed as a whole, are properly interpreted as being an endoscope as seen in Figures 1 and 9. Thus as broadly as claim, Jones disclose an endoscope having an irrigation port as the sheath is interpreted as being part of the endoscope when viewed as a whole. Furthermore, the words "configured to" in the claims may be properly interpreted

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as “capable of,” and “capable of” does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./  
Examiner, Art Unit 3739

/Linda C Dvorak/  
Supervisory Patent Examiner, Art  
Unit 3739

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